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EXAMINER

STORMER, RUSSELL D

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3617

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 23

Application Number: 09/775425

Filing Date: February 1, 2001

Appellant(s): L. A. Chase et al

Remy Van Ophem

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 5, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct. However, a departure from the final rejection has been made as a result of the appeal conference in order to reduce the instances of multiple rejections of the same claims and place the application in better condition for a decision on the appeal and to avoid a remand from the Board of Appeals. The rejections that are argued in this Examiner's Answer are necessary due to claim dependency and the combinations of claims met by the references used.

The changes are as follows:

The rejection of claims 1, 4, 5, 8, 10, and 11 under 35 USC 102 over Eikhoff has been dropped.

The rejection of claims 1, 10, and 11 under 35 USC 102 over Buerger has been dropped.

The rejection of claims 1, 4, 5, 6, 11, 15, 18, 19, 20, and 25 under 35 USC 102 over Maloney et al has been dropped.

The rejection of claims 2, 3, 6, 8, and 9 under 35 USC 103 over Eikhoff has been dropped.

Therefore, Issues 2, 3, 5, and 9 in Appellants' statement of the issues will not be addressed in the Examiner's Answer.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-6, 8-11, 13-20, 22-25, 27, and 28 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5143426	Todd	9/1992
5368370	Beam	11/1994
5564791	Chase et al	10/1996
5842750	Murray et al	12/1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 10, and 11 are rejected under 35 U.S.C. 102 as being clearly anticipated by Todd. This rejection is set forth in paragraph 4 of the prior Office Action, Paper No. 16.

Claims 1, 4, 5, 10, 11, 15, 18, 19, 20, 24, and 25 are rejected under 35 U.S.C. 102 as being clearly anticipated by Beam. This rejection is set forth in paragraph 7 of the prior Office Action, Paper No. 16.

Claims 1, 4, 6, 8, 11, 13, 14, 15, 18, 20, 22, 25, 27, and 28 are rejected under 35 U.S.C. 102 as being clearly anticipated by Chase et al. This rejection is set forth in paragraph 9 of the prior Office Action, Paper No. 16.

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Claims 1, 2, 3, 9, 11, 15, 16, 17, 23, and 25 are rejected under 35 U.S.C. 102 as being clearly anticipated by Murray et al. This rejection is set forth in paragraph 10 of the prior Office Action, Paper No. 16.

Claims 2, 3, 8, and 9 are rejected under 35 U.S.C. 103 as being obvious over Todd. This rejection is set forth in paragraph 12 of the prior Office Action, Paper No. 16.

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(11) Response to Arguments

Appellants argue that the claims are directed to a wheel and overlay assembly in which the overlay has an outer peripheral lip or diameter that is aligned with the radially outermost edge of the lip flange of the wheel rim such that the lip of the overlay cannot extend radially beyond the edge of the rim regardless of tolerance variations. Appellants further argue that any drawing or statement that disclose a wheel cover or overlay designed to extend radially to the edge of the wheel flange lip without specifically accounting for tolerance variations to ensure that the wheel *cannot* extend beyond the edge of the rim flange does not anticipate claims 1 and 15. See page 8 of the Brief. Appellants' statement, taken further, is to argue that of the prior art references used in the rejection, the wheel covers or overlays *can* possibly extend beyond the outer edge of the rim flange even though such is not shown or disclosed because of tolerance variations in the rim flange or the overlay. The Examiner does not agree with this argument because Appellants are reading subject matter into the references that is not shown in the drawings or disclosed in the specifications of the any of the applied references, either explicitly or implicitly. None of the references give any hint that their respective wheel covers or overlay *could ever* extend beyond the radially outermost edge of the rim flange for any reason. None of these references could be used to teach or imply that the outer lips of the overlays could extend beyond the outermost edge of the rim flange as they all show the overlays and wheel covers to extend up to or just short of the outermost edge of the rim flanges. Contrary to Appellants' statements on pages 8-10 of the Brief, those of ordinary skill in the art would never see these references as teaching or suggesting that the wheel covers could extend beyond the outermost edge of the wheel rim flange.

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With respect to the rejection over Todd, Appellants argue that the "limited disclosure" (page 11 of the Brief) of Todd allows one of ordinary skill to know that this "implicitly allows for the wheel cover to extend beyond the outermost edge of the wheel due to tolerance variations..." Such statement cannot be correct. There is no reason to believe that the overlay of Todd could ever extend beyond the outermost edge of the wheel rim. There is no teaching for this. If anything, one of ordinary skill would know that any possible tolerance variations would have been accounted for in the design process so that the overlay would extend to the edge of the wheel rim as shown and taught and not beyond. The teachings of Todd are not incidental, as suggested by Appellants. They are very clear.

Appellants apply the same arguments to the patents of Beam, Chase et al, and Murray et al on page 14 of the Brief stating that none of the references disclose an overlay arranged within a predetermined margin less than the outer diameter of the wheel. The Examiner disagrees.

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Beam teaches an overlay for a wheel comprising an outer edge 48 on the overlay which must be forcibly urged past the lip 46 of the rim flange (lines 58-67 of column 5 of Beam) in a snap fit so that the overlay will be prevented from removal by the lip 46. If the peripheral outer edge 48 of Beam were to extend beyond the outermost edge of the rim flange (14 in figure 5 of Beam) as Appellants suggest, then there is no possible way for the edge to snap fit under the lip 46. As argued by Appellants, the wheel and overlay assembly of Beam would be *inoperative*. Therefore, even when allowing for the tolerance variations proposed by Appellants, the outer edge 48 of the overlay can *never* extend beyond the outermost edge 14 of the rim flange because such a reconstruction of the overlay of Beam would be contrary to the teachings of Beam and would not allow the overlay and wheel rim flange to function designed. In fact, those of ordinary skill in the art would know that the tolerances of the overlay must be very tight so that the outer edge 48 of the overlay would be sized to just fit inside the lip 46 with a snap fit so that the lip can retain the edge of the overlay as taught by Beam.

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Chase et al teaches an overlay applied to a wheel and having an outermost lip 122a, 222, 322a, and 422 (figures 2-5, respectively) that extends near, but not radially as far as the flange lip 120, 220, 320, 420 of the wheel rim so as to accommodate the mounting of a balance weight 124, 224, 324, 424. The lip 122a, etc, does not even extend as far axially as the rim flange, and therefore could never extend radially as far, or beyond as suggested by Appellants. In fact, to suggest that any tolerance variation might allow the lip 122a, etc. to extend radially beyond the outermost extent of the rim flange 120, etc. is actually contrary to the teachings of Chase et al as this would render the invention *inoperative* as it would preclude the attachment of the balance weight. The specific teachings of Chase et al to size and shape the outer periphery of the overlay to accommodate a balance weight would be destroyed. Those of ordinary skill would not find Appellants' suggested modification inherent, or even possible.

Murray et al teaches an overlay molded directly to the wheel and molding process is specifically designed to prevent any material 3 from extending beyond the edge 39 of the rim so that a final trimming of the edge of the rim is not necessary. This prevents damage to the surface 13 of the overlay. See lines 60-67 of column 4; 1-15 and 36-55 of column 5; 59-67 of column 6; 1-9 of column 7; and 40-58 of column 9 of Murray et al. From the teachings of Murray et al, there is no reason to believe that the overlay 3 ever extends beyond the radially outermost edge 39 of the rim flange because Murray et al specifically teaches against this possibility, and in fact, this patent is drawn to preventing the material of the overlay from extending beyond the outermost edge of the rim. There would be no tolerance variations in the overlay because the overlay is designed to extend to the edge of the rim flange at 39 and not extend beyond the edge.

With respect to the arguments against the rejection of claims 2 and 3 under 35 USC 103 over Todd, it is noted that since there is no suggestion in Todd that the lip of the overlay could ever extend beyond the radially outermost edge of the rim flange, one of ordinary skill in the art could readily determine suitable tolerances for the overlay. It is well-known in the art that wheel covers are designed to have a tolerance in their fit and alignment with a wheel.

Applicant suggests that a prima facie case of obvious has not been established, but it is noted that those of ordinary skill are quite capable of determining suitable margins of tolerance based on the manufacturing equipment used, the style and material of the wheel cover, the intended cost of the wheel cover (tighter tolerances cost more and may be unnecessary) and many other factors. Therefore, it would have been obvious to set the tolerances of the overlay of Todd to any suitable or desired dimension.

With respect to claims 8 and 9, it is notoriously well-known in the art to apply a heat-resistant metal-plated finish or a heat-resistant paint finish to a wheel cover or overlay and those of ordinary skill in the art would easily find it obvious to apply such finishes to the overlay of Todd.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Russell D. Stormer

rds

July 28, 2003

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mtle